

REMARKS/ARUMENTS

I. Status of the Claims

Claims 1-7, 9-17, 19-25, and 28-32 are currently pending in this application, with claims 28-32 being withdrawn from consideration until their rejoinder. Claim 26 was cancelled without prejudice. Claims 1, 2, 11, 12, 25, 26, and 28-32 have been amended. New claims 34 and 35 were added. Support for the new claims and amendments can be found through out the specification and in the original claims 1, 2, 11, 12, 25, 26, and 28-32. It is respectfully submitted that no new matter is being introduced by virtue of these amendments.

II. Double Patenting

In the Office Action, claims 1-7, 9, 10-17, and 19-26 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 16 of the parent case, U.S. Patent No. 6,730,696 to Kozak et al. The Examiner stated that “[o]ne having ordinary skill in the art would find the claims 1-7, 9-17, and 19-26 prima facie obvious because one would be motivated to employ the compounds/compositions of Kozak et al. as agents treating inflammation to obtain instant claimed compounds/compositions of formula (I).”

In response, Applicants respectfully submit that a patent issuing on an application with respect to which a restriction requirement has been made “shall not be used as a reference ... against a divisional application ... if the divisional application is filed before the issuance of the patent on the other application. (*See 35 U.S.C. 121*, third sentence) Applicants further submit that “[t]he third sentence of 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made ... as a reference against any divisional application, if the divisional application is filed before the issuance of the patent.” *See Manual of Patent Examining Procedure*, Section 804.01.

The present application is a divisional application of U.S. Patent Application Serial No. 09/856,009 (“the parent application”), filed on May 16, 2001 as a National Phase of International Application No. PCT/IL99/00623, filed November 18, 1999. At the time of filing, the independent claims of the parent application were all directed in part to a compound of Formula I

wherein D was “the residue of a nonsteroidal anti-inflammatory drug.” Claim 8 further provided that D was “selected from the group consisting of diclofenac, indomethacin, ibuprofen, naproxen and 6-methoxy-2-naphthylacetic acid.” In response to the Restriction Requirement, mailed on January 6, 2003, a species wherein D was “the residue of indomethacin” was elected and examined. The parent application issued as U.S. Patent No. 6,730,696 on May 4, 2004, with all independent claims directed in part to the compound of formula I, wherein D is “the residue of indomethacin.”

The present application was filed as a divisional application of the parent case on January 11, 2004. In response to the Restriction Requirement, mailed October 10, 2005, a species of compound of Formula I wherein “D is ibuprofen” was elected. Because the present application was filed before the parent application issued as a patent, the third sentence of 35 U.S.C. 121 prohibits the use of the parent case, U.S. Patent No. 6,730,696, as a reference against the present application.

Therefore, it is respectfully requested that the double patenting rejection be removed.

III. Claim Objection

In the Office Action, claims 25 and 26 were objected to. The Examiner stated “the instant claims do not limit named diseases of intent of use.” The Examiner further stated that “[i]ncorporation of named diseases into the claim, would obviate the objection” and referred to page 9, lines 1-10 of the specification.

In response, Applicants respectfully submit that the named diseases of page 9, lines 1-10 have been incorporated into amended claim 25 as suggested by the Examiner. Accordingly, it is respectfully requested that the objection be withdrawn.

IV. Conclusion

Reconsideration of the present application, as amended, is respectfully requested. If the Examiner has any questions or concerns regarding this response, the Examiner is respectfully requested to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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